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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,632	12/26/2001	Arthur Alexander Godoy		4475

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EXAMINER

MEISLIN, DEBRA S

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 04/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

Office Action Summary

Application No.

10/025,632

Applicant(s)

GODOY ET AL.

Examiner

Debra S. Meislin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The substitute specification, filed March 24, 2003, has not been entered since it includes new matter. The following constitutes new matter:

page 5, paragraph [0011], lines 7-8 of paragraph [0011.1];

page 6, line 1 of paragraph [0011.4], line 3 of paragraph [0014];

page 7, lines 4 and 10 of paragraph [0020], paragraph [0024], lines 1 and 6 of paragraph [0025], line 1 of paragraph [0026];

page 8, lines 7-9 of paragraph [0028.2];

page 10, lines 7-8 of the abstract.

2. Claims 24 and 33-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 24, "between $\frac{1}{4}$ " and $\frac{3}{4}$ " from an active end" constitutes new matter.

In claim 33, "an armature bar removably attached to said distal end of said needle", "a tube grip surrounding said tube and attached by at least one set screw to the tube", "a bracket attached to the frame", "removing said set screw", "removing said tube grip", and "removing said needle from said armature bar" all constitutes new matter.

In claim 34, "an armature bar removably attached to the distal end of said needle", "a tube grip surrounding said tube and attached by at least one set screw", "a bracket attached to the frame", "inserting said needle...bar", and "sliding said tube grip over said tube" constitutes new matter.

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In claim 35, "an armature bar removably attached to the distal end of said needle", "a tube grip surrounding said tube and attached by at least one set screw", "a bracket attached to the frame", and "between a depth of 1/16" and 1/4" constitutes new matter.

3. Claims 9-13 and 17-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, it is not clear if applicant is claiming a tube vice frame apparatus by itself or in combination with a tattoo machine. Also, in line 5, "the active end" lacks antecedent basis.

In claim 12, lines 6-7 are not grammatically understood. It is not clear as to what element(s) is "and inserted within said cylindrical piece" It is not clear as to what is meant by "an operator may select components of desired size and assemble said kit".

In claim 13, line 15, "may be" is vague and indefinite since the scope cannot be determined. Either the ferrule "is" or "is not" compressed.

In claim 17, line 6, it is not clear as to what element(s) is "attached to said frame".

In claim 18, "said hollow threaded rod" lacks antecedent basis.

Claim 21 is redundant in view of paragraph "(b)" of claim 17.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoya.

Itoya discloses an elongated, hollow, externally threaded cylindrical piece "10" with a tapered internal surface, a ring "12" (figure 5) with smooth internal and external surfaces and beveled ends, and a nut "14". Figures 10, 13 and 15-18 disclose that the ring may be split. It would have been obvious to one having ordinary skill in the art to form the ring "12" of Itoya as split to firmly grip a workpiece as taught by Itoya in figures 10, 13 and 15-18.

6. Claims 1-11, 16-28, 30, and 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binaris et al or Nightingale in view of Itoya.

Binaris et al or Nightingale disclose all of the claimed subject matter except for having a securing means in the form of a nut, a ferrule, and a receiving piece; a brass ferrule; a cast frame and receiving piece; or a machined receiving piece. Itoya discloses a securing means in the form of a nut, a ferrule, and a receiving piece. Itoya further discloses a smoothed surface ferrule with tapered ends and a split ferrule. It would have been obvious to one having ordinary skill in the art to form the connection of Binaris et al or Nightingale as a nut, a smooth surfaced and tapered ferrule which may be split, and a receiving piece to allow for the parts to be removable as taught by Itoya.

The examiner takes Official Notice that brass ferrules and clockwise threading is notoriously old and well known in the art such as in plumbing connections. It would have been obvious to one having ordinary skill in the art to form the ferrule of Binaris et al or Nightingale as modified by Itoya out of brass and with clockwise threading as such is old and well known in the art to provide a snug connection.

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It would have been obvious to form the frame of Binaris et al or Nightingale by casting as such would have been an obvious method of manufacture to one having ordinary skill in the art. The examiner further takes Official Notice that casting a frame is notoriously old and well known in the art.

The examiner takes Official Notice that machining is an old and well known in the art tool making. Consequently, it would have been obvious to one having ordinary skill in the art to machine the device of Binaris et al or Nightingale as modified by Itoya as such is old and well known in the art of tool making.

It would have been an obvious matter of design choice to protrude the receiving piece between $\frac{1}{4}$ " and $\frac{3}{4}$ ", and machining inwards to a depth of between $\frac{1}{16}$ " and $\frac{1}{4}$ " since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Invention will not be decided on narrow issue of degree; mere changing of form, proportions, or size will not alone constitute invention; this is true even though change brought about better results.

7. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Binaris et al or Nightingale in view of Itoya in view of Krusche.

Krusche discloses a nut with a knurled exterior surface. It would have been obvious to one having ordinary skill in the art to form the device of Binaris et al or Nightingale with a knurled exterior surface to provide a better gripping surface as taught by Krusche.

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8. Claims 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Binaris et al or Nightingale in view of Itoya in view of Yacowitz.

Yacowitz discloses tattoo needle holder being made of brass. It would have been obvious to one having ordinary skill in the art to form the device of Binaris et al or Nightingale out of brass as such is an obvious matter of choice as taught by Yacowitz.

9. Claim 13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

10. Applicant's arguments, filed March 24, 2003, have been fully considered but they are not persuasive.

The original four-page specification does not support the new matter in the eight-page substitute specification, as set forth in paragraph 1, above. The new matter recitations are more limiting than the original disclosure recitations that applicant contends is merely a rewording. As an example, the original disclosure does not disclose a rod (14) being "tapered at both ends". Additionally, the terms "preferably" and "optimally" are more limiting than originally disclosed. As a final example, the original disclosure makes no mention of set screws or a removable grip.

Applicant's arguments with respect to claim 12 have been considered but are moot in view of the new ground(s) of rejection. Additionally, Itoya discloses an elongated, hollow, externally threaded cylindrical piece "10" with a tapered internal surface, a ring "12" (figure 5) with smooth internal and external surfaces and beveled ends, and a nut "14". Figures 10, 13 and 15-18 disclose that the ring may be split. It

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would have been obvious to form the ring "12" of Itoya as split to firmly grip a workpiece as taught by Itoya in figures 10, 13 and 15-18.

In response to applicant's argument that the invention was for use in a tattooing device, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is some teaching, suggestion, or motivation to do so found in the references themselves since Itoya discloses an improved joint connection which brings complete sealing and locking effects which may also be disassembled.

In response to applicant's argument on pages 29-35, that the references fail to show certain features of applicant's invention, it is noted that the features upon which

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applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).


In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that Itoya is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art is reasonably pertinent to the particular problem (proving a type of threaded rod connection between elements) with which the applicant was concerned. One would clearly look to the connection art for the limitations set forth in the claims directed to a specific type of connection.

11. Any inquiry concerning this communication should be directed to Debra S. Meislin at telephone number 703-308-3671. Official responses may be faxed to 703 872-9302 and after final responses may be faxed to 703 872-9303.

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Debra S. Meislin
Primary Examiner
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4/18/03